



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,258	09/06/2000	JIMMIE D. BURROW	B-68826	9092

7590 09/11/2003

Kenneth R Glaser
Gardere Wynne Sewell LLP
1601 Elm Street Suite 3000
Dallas, TX 75201-4761

EXAMINER

CHAN, SING P

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,258

Applicant(s)

BURROW ET AL.

Examiner

Sing P Chan

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-26 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-26 and 29-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 8-26, 29-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recited forming a substantially planar surface or indentation or window, where the indentation depth is at least about equal to the thickness of the image sheet. The specification does not provide support or description to the indentation depth at least about equal to the thickness of the image sheet.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 15, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589) and Kuroda (U.S. 4,160,685).

Beleckis discloses a method of forming a notebook. The notebook cover is formed by providing a rigid plastic material covered by a printed plastic film. (Col 5, lines 1-10) Beleckis is silent as to bonding the printed film with RF energy to the plastic material and to debossing the material to form a planar indentation with a depth at least as great as the thickness of the film. However, bonding a printed film onto a plastic material and forming a planar indentation with a depth at least as great as the thickness of the film are well known and conventional as shown for example by Groswith, III et al. Groswith, III et al discloses a method of debossing a binder, i.e. a notebook. The method includes providing a binder with a cover form of plastic material, (Col 8, lines 29-35) a logo die, and logo die foil tape, (Col 8, lines 53-56) superposing the tape over the binder cover, lowering the die or hammer with a heater, debossing and transferring the transferable material from the tape to the depress area of the cover, which form a planar indentation with the depth at least as great as the thickness of the tape. (Col 10, lines 45-59 and Figure 26)

It would have been obvious to one skilled in the art at the time the invention was made to deboss the binder cover with a logo or debossing die to form a planar indentation, which recess the image film into the indentation as disclosed by Groswith, III et al in the method of Beleckis to easily recess the image film and to prevent wearing on the printed image. Groswith, III et al does disclose the heating element is an electrical resistance heating element, (Col 20, lines 64-68) but is silent as to the energy is RF energy. However, using RF energy to heat a debossing or embossing die is well known and conventional as shown for example by Kuroda. Kuroda discloses a method

of making an appliqué article. The method includes superimposed the sheet member and imaged sheet with the second side facing the sheet member onto a base sheet in the bonding die, and bonding and indenting the member with heat and pressure with a heating platen using high frequency, i.e. RF, energy. (Col 3, lines 49-62, Col 4, lines 36-59) The process of superimposing the sheet member and imaged sheet in the bonding step is considered to satisfy the recited step of placing the imaged sheet onto the debossing die and placing the member in engagement with the imaged sheet.

It would have been obvious to one skilled in the art at the time the invention was made to provide a RF heating device for the heating die as disclosed by Kuroda in the method of Beleckis to provide an easy and simple heating device to heat the die and platen, which is readily available and easy obtained.

5. Claims 2, 8-10, and 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589) and Kuroda (U.S. 4,160,685) as applied to claim 1, and further in view of Aitkens et al (U.S. 5,380,044).

Regarding claims 2 and 13, Beleckis as modified above is silent as printing multiple images on a larger imaged sheet and cutting the imaged sheet from a larger imaged sheet prior to placing the imaged sheet onto the sheet member. Aitkens et al discloses a method of forming an identification card. The method includes printing the identification layouts on a larger vinyl laminate, i.e. larger imaged sheet, and cutting out the individual card layout prior to placing the imaged sheet onto the substrate, i.e. sheet member. (Col 10, lines 3-33)

It would have been obvious to one skilled in the art at the time the invention was made to print a number of images onto a larger sheet and cutting the imaged sheet into individual sheets as disclosed by Aitkens et al in the method of Beleckis to allow easy handling and storage of the imaged sheet until needed.

Regarding claim 8, Beleckis as modified above discloses the image sheet includes emboss paper or printed plastic film, which is considered to includes opaque pre-colored material, is silent as to the printing comprises of inkjet printing, photostatic printing, and thermal ribbon printing. But these printing methods are well known and convention to one in the art shown by the availability of inkjet printers, laser printers, and thermal ribbon printers and also by Aitkens et al. Aitkens et al discloses the printing of the imaged sheet by video color printer, which is considered to be an ink jet printer.

It would have been obvious to one skilled in the art at the time the invention was made to print the images on a larger sheet material to form multiple image sheets with inkjet printer, photostatic printer, or thermal ribbon printer as disclosed by Aitkens et al in the method of Beleckis wherein the printer are readily available and easily used and also prevent unnecessary waste of the sheet material.

Regarding claim 9, Beleckis as modified above is silent as to the image printed on the imaged sheet is provided by scanning and copying an image source and transferring to the printer. However, scanning and copying an image from an image source is well known and conventional as shown for example by Aitkens et al. Aitkens et al discloses the optical scanner to scanning any graphical design, i.e. image, and

transferring to the processor and outputting the final image to the printer. (Col 5, lines 5-10 and Col 7, lines 9-12)

It would have been obvious to one skilled in the art at the time the invention was made to provide an optical scanner as disclosed by Aitkens et al in the method of Beleckis to easily copy and scan any image into a processor for printing.

Regarding claim 10, Beleckis as modified above is silent as to applying an ink receptive coating to the image sheet. However, applying an ink receptive coating onto a plastic image sheet is well known and conventional as shown for example by Aitkens et al. Aitkens et al discloses the image sheet is coated with an ink absorbing material. (Col 8, lines 4-32)

It would have been obvious to one skilled in the art at the time the invention was made to coat the image sheet with an ink receptive coating as disclosed by Aitkens et al in the method of Beleckis to allow better adhesion of the ink to the image sheet.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589), Kuroda (U.S. 4,160,685) and Aitkens et al (U.S. 5,380,044) as applied to claim 10 above, and further in view of Lu et al (U.S. 5,891,552).

Beleckis as modified above does not disclose providing a texture prior to applying a coating. However, one in the art would appreciate treating the plastic film prior to coating to allow better adhesion of the coating to film and such treatment, which would provide a texture surface is well known and conventional. For example, Lu et al discloses the film is treated with flame or corona treatment to provide a high-energy

surface for better adhesion of the coating or primer and is considered to provide textured surface. (Col 7, lines 1-7)

It would have been obvious to one skilled in the art at the time the invention was made to treat the surface of the film as disclosed by Lu et al in the method of Beleckis to provide a high energy surface to allow better adhesion of coating and primer.

7. Claims 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589), Kuroda (U.S. 4,160,685), and Aitkens et al (U.S. 5,380,044) as applied to claims 1, 2, and 13 above, and further in view of Jenkins (U.S. 5,974,230).

Beleckis as modified above is silent as to providing a clear polyvinyl chloride cover sheet over the larger image sheet. However, providing a polyvinyl chloride cover sheet over a larger imaged sheet is well known and conventional as shown for example by Jenkins. Jenkins discloses a clear vinyl cover sheet with a pressure sensitive adhesive is laminated to the larger image sheet prior to die cutting to individual labels. (Col 2, lines 65-66, Col 4, lines 49-54, and Figure 2)

8. Claims 17, 19, 24-26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589), Kuroda (U.S. 4,160,685), and Aitkens et al (U.S. 5,380,044).

Regarding claims 17, 19, 24, 25, and 31, Beleckis discloses a method of forming a notebook. The notebook cover is formed by providing a rigid plastic material covered by a printed plastic film. (Col 5, lines 1-10) Beleckis is silent as to bonding the printed film with RF energy to the plastic material and debossing the material to form a planar

indentation with a depth at least as great as the thickness of the film. However, bonding a printed film onto a plastic material and forming a planar indentation with a depth at least as great as the thickness of the film are well known and conventional as shown for example by Groswith, III et al. Groswith, III et al discloses a method of debossing a binder, i.e. a notebook. The method includes providing a binder with a cover form of plastic material, (Col 8, lines 29-35) a logo die, and logo die foil tape, (Col 8, lines 53-56) superposing the tape over the binder cover, lowering the die or hammer with a heater, debossing and transferring the transferable material from the tape to the depress area of the cover, which form a planar indentation, i.e. a window, with the depth as great as the thickness of the tape. (Col 10, lines 45-59)

It would have been obvious to one skilled in the art at the time the invention was made to deboss the binder cover with a logo or debossing die to form a planar indentation, which recess the image film into the indentation as disclosed by Groswith, III et al in the method of Beleckis to easily recess the image film and to prevent wearing on the printed image. Groswith, III et al does disclose the heating element is an electrical resistance heating element, (Col 20, lines 64-68) but is silent as to the energy is RF energy. However, using RF energy to heat a debossing or embossing die is well known and conventional as shown for example by Kuroda. Kuroda discloses a method of making an appliqué article. The method includes superimposed the sheet member and imaged sheet with the second side facing the sheet member onto a base sheet in the bonding die, and bonding and indenting the member with heat and pressure with a heating platen using high frequency, i.e. RF, energy. (Col 3, lines 49-62, Col 4, lines

36-59) The process of superimposing the sheet member and imaged sheet in the bonding step is considered to satisfy the recited step of placing the imaged sheet onto the debossing die and placing the member in engagement with the imaged sheet.

It would have been obvious to one skilled in the art at the time the invention was made to provide a RF heating device for the heating die as disclosed by Kuroda in the method of Beleckis to provide an easy and simple heating device to heat the die and platen, which is readily available and easy obtained. Kuroda is silent as to transferring an image to a processor and outputting the image to a printer, printing multiple images on a larger imaged sheet and cutting the imaged sheet from a larger imaged sheet prior to placing the imaged sheet onto the sheet member. Aitkens et al discloses a method of forming an identification card. The method includes transferring images into a C.P.U., i.e. a processor, outputting the images to a color printer, printing the identification layouts on a larger vinyl laminate, i.e. larger imaged sheet, and cutting out the individual card layout prior to placing the imaged sheet onto the substrate, i.e. sheet member. (Col 6, line 60 to Col 7, line 49 and Col 10, lines 3-33)

It would have been obvious to one skilled in the art at the time the invention was made to transfer the image to a processor, outputting the image to a printer, print a number of images onto a larger sheet and cutting the imaged sheet into individual sheets as disclosed by Aitkens et al in the method of Beleckis to allow faster and easier handling and storage of the image and imaged sheet until needed.

Regarding claim 26, Beleckis is silent as to applying an ink receptive coating to the image sheet. However, applying an ink receptive coating onto a plastic image sheet

is well known and conventional as shown for example by Aitkens et al. Aitkens et al discloses the image sheet is coated with an ink absorbing material. (Col 8, lines 4-32)

It would have been obvious to one skilled in the art at the time the invention was made to coat the image sheet with an ink receptive coating as disclosed by Aitkens et al in the method of Beleckis to allow better adhesion of the ink to the image sheet.

9. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589), Kuroda (U.S. 4,160,685), and Aitkens et al (U.S. 5,380,044) as applied to claim 17 above, and further in view of Kaule (U.S. 5,817,205).

Beleckis as modified above does not disclose debossing the sheet member to form a guide device prior to placing the image sheet onto the substrate for bonding. However, debossing a substrate to form a guide device to aid in guiding an imaged sheet for bonding is well known and conventional as shown for example by the Kaule. Kaule discloses a method of applying a hologram to a paper substrate. The method includes running the paper substrate into a glazing unit with cylinders with raised areas to produce indented surface, applying bonding agent to the glazed stripe or stripes and applying an endless hologram, which is guided to the glazed stripe or stripes. (Col 9, lines 25-46 and Figure 2 and 3)

It would have been obvious to one skilled in the art at the time the invention was made to emboss or deboss the member sheet to provide indentation on the sheet member as disclosed by Kaule in the method of Beleckis wherein the indentation would provide a guiding and positioning mean to properly place the an image sheet or film.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589), Kuroda (U.S. 4,160,685), and Aitkens et al (U.S. 5,380,044) as applied to claim 17 above, and further in view of Pargh (U.S. 2,602,560).

Beleckis as modified above does not disclose directing a light beam on a predetermined location on the sheet member for guiding the placement of the imaged sheet. However, providing a light beam on the article or substrate to direct the placement of sheet or label is well known and conventional as shown for example by Pargh. Pargh discloses a labeling machine. The labeling machine includes a number of light rays from light sources, which provided spots or focus points on the surfaces of the article and indicate the exact point a label is to be placed. (Col 13, line 64 to Col 14, line 15)

It would have been obvious to one skilled in the art at the time the invention was made to provide light beams to aid in directing the placement of the imaged sheet onto the sheet member as disclosed by Pargh in the method of Beleckis to allow fast and easy placement of the imaged sheet and proper align the imaged sheet on the die.

11. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589), Kuroda (U.S. 4,160,685), and Aitkens et al (U.S. 5,380,044) as applied to claim 17 above, and further in view of Jenkins (U.S. 5,974,230).

Beleckis as modified above does not discloses laminating a transparent sheet of polyvinyl chloride over the imaged sheet. However, laminating a transparent sheet of

polyvinyl chloride over the imaged sheet is well known and conventional as shown for example by Jenkins. Jenkins discloses a method of forming labels. The method includes providing a clear vinyl cover sheet is laminated over the printed sheet prior to die cutting into individual image sheets. (Col 4, lines 47-54)

It would have been obvious to one skilled in the art at the time the invention was made to provide a transparent polyvinyl chloride sheet over the imaged sheet as disclosed by Jenkins in the method of Beleckis to protect the image on the imaged sheet from damage.

12. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beleckis (U.S. 4,981,386) in view of Groswith, III et al (U.S. 5,441,589), Kuroda (U.S. 4,160,685), and Kaule (U.S. 5,817,205).

Beleckis discloses a method of forming a notebook. The notebook cover is formed by providing a rigid plastic material covered by a printed plastic film. (Col 5, lines 1-10) Beleckis is silent as to bonding the printed film with RF energy to the plastic material and debossing the material to form a planar indentation with a depth at least as great as the thickness of the film. However, bonding a printed film onto a plastic material and forming a planar indentation with a depth at least as great as the thickness of the film are well known and conventional as shown for example by Groswith, III et al. Groswith, III et al discloses a method of debossing a binder, i.e. a notebook. The method includes providing a binder with a cover form of plastic material, (Col 8, lines 29-35) a logo die, and logo die foil tape, (Col 8, lines 53-56) superposing the tape over the binder cover, lowering the die or hammer with a heater, debossing and transferring

Art Unit: 1734

the transferable material from the tape to the depress area of the cover, which form a planar indentation with the depth as great as the thickness of the tape. (Col 10, lines 45-59)

It would have been obvious to one skilled in the art at the time the invention was made to deboss the binder cover with a logo or debossing die to form a planar indentation, which recess the image film into the indentation as disclosed by Groswith, III et al in the method of Beleckis to easily recess the image film and to prevent wearing on the printed image. Groswith, III et al does disclose the heating element is an electrical resistance heating element, (Col 20, lines 64-68) but is silent as to the energy is RF energy. However, using RF energy to heat a debossing or embossing die is well known and conventional as shown for example by Kuroda. Kuroda discloses a method of making an appliqué article. The method includes superimposed the sheet member and imaged sheet with the second side facing the sheet member onto a base sheet in the bonding die, and bonding and indenting the member with heat and pressure with a heating platen using high frequency, i.e. RF, energy. (Col 3, lines 49-62, Col 4, lines 36-59) The process of superimposing the sheet member and imaged sheet in the bonding step is considered to satisfy the recited step of placing the imaged sheet onto the debossing die and placing the member in engagement with the imaged sheet.

It would have been obvious to one skilled in the art at the time the invention was made to provide a RF heating device for the heating die as disclosed by Kuroda in the method of Beleckis to provide an easy and simple heating device to heat the die and platen, which is readily available and easy obtained. Kuroda does not disclose

Art Unit: 1734

debossing the sheet member to form a guide device prior to placing the image sheet onto the substrate for bonding. However, debossing a substrate to form a guide device to aid in guiding an imaged sheet for bonding is well known and conventional as shown for example by the Kaule. Kaule discloses a method of applying a hologram to a paper substrate. The method includes running the paper substrate into a glazing unit with cylinders with raised areas to produce indented surface, applying bonding agent to the glazed stripe or stripes and applying an endless hologram, which is guided to the glazed stripe or stripes. (Col 9, lines 25-46 and Figure 2 and 3)

It would have been obvious to one skilled in the art at the time the invention was made to emboss or deboss the member sheet to provide indentation on the sheet member as disclosed by Kaule in the method of Beleckis wherein the indentation would provide a guiding and positioning mean to properly place an image sheet or film.

Art Unit: 1734

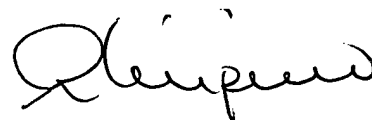
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P Chan whose telephone number is 703-305-3175. The examiner can normally be reached on Monday-Friday 7:30AM-11:15AM and 12:15PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Chan Sing P

spc



RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700